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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,174	01/17/2002	Carol Myers	4532670/58750	3165

7590

05/05/2004

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EXAMINER

HENDRICKS, KEITH D

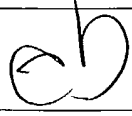
ART UNIT

PAPER NUMBER

1761

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/052,174	MYERS ET AL. 	
	Examiner	Art Unit	
	Keith Hendricks	1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2-17-04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2 and 4-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

NOTE: It appears that applicant has cancelled claim 3. If applicant is canceling a claim, the body & text of the claim is not to be recited. Simply reciting "3. (canceled)", is sufficient.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2 and 4-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

i) The amended amount of antioxidant, at part (b) of claims 1 and 4, to recite a lower limit of "about 0.03" percent, does not appear to be supported by the original disclosure. Furthermore, newly added claims 6-13 recite specific weight amounts which are not supported by the original disclosure. At page 8 of the response, applicant states that "great care has been taken to avoid the introduction of new subject matter into the application as a result of the foregoing modifications." However, this effort was not well translated in the submitted response and claim amendments. Applicant did not set forth those portions of the specification from where the claim amendments were derived, leaving the Examiner to search the specification for support, and attempt to translate percentages and data figures in an effort to match such to the claims. This effort was unsuccessful, and it does not appear that the newly-claimed subject matter was described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors had possession of the claimed invention at the time the application was filed.

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For example, *at best*, page 5 of the specification provides a solution containing only organic acids, with a total amount of 700 grams. Given the percentage of total preservative composition used per ton (2000 pounds, as generally accepted in the United States), as claimed (“between about 0.05 and about 2.5 weight percent”), such a composition made of 90-99.9 % organic acids would translate to 1.543235835294143 pound (lb) (avoirdupois), or 1.875460216503299 pound (lb) (troy or apothecary). Neither of these figures are equivalent to the now-claimed “1.5 pounds” provided as a lower limit in part (a) of new claims 6 and 10. Thus -- and this is merely an example of *each* newly-claimed amount -- the specification does not provide support for the claims as currently recited. Furthermore, it is also important to note that, for the use of at least the terms “ton”, and “pound”, there is provided no standard unit within the specification or even applicant’s response. There are at least three scientifically accepted descriptions of a “ton”, including a “metric ton”, a “short ton” of 2000 pounds, and a “long ton” of 2240 pounds. Still further, as seen above, there are two generally accepted standards for a “pound”, as well. Thus it is unclear from where applicants derive the claimed amounts, and by what method of conversion from the metric data recited in the specification. Note that these principles apply to each of the added claimed amounts within the response.

ii) Applicant has not demonstrated support for the criticality of a lower limit amount of “about 0.03” percent, regarding the amount of antioxidant in the composition of claims 1-2, 4-5 and 14-15. Similarly, applicant has not demonstrated support for the criticality of either the lower limit or upper limit weight amounts as recited for each component of the composition in new claims 6-13. Even if these specific amounts and percentages were to be found within the specification as originally filed, there is no teaching that these would serve as the endpoint in a claimed range. As an example, there does not appear to be support within the specification for amending the lower limit percentage of antioxidants (part ‘b’ of claims 1 and 4), from “about 0”, to now recite “about 0.03”. The ranges originally provided state that the lower amount is zero, i.e. it need not be present, and the specification does not provide the rationale, guidance or suggestion for selecting a lower percentage amount of “about 0.03”. Applicants may not randomly amend the limits of a disclosed range, without demonstrating a corresponding criticality to this new endpoint. Simply because an originally-disclosed range encompassed such a percentage, does not mean that it provides support for the new recitation of this amount as an endpoint within a range.

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Claim Rejections - 35 USC § 102

The previous prior art rejections applied under this statute are withdrawn at this point in prosecution. Applicants are correct in stating that the previously-applied prior art references of Huiston and Maytas et al. teach "only organic acids and not the use of an antioxidant or surfactant as recited in the present form of the claims." Applicants also correctly state that "Fahnenstich et al. teaches nothing whatsoever about the use of antioxidants." The references no longer anticipate the current claims, due to applicant's amendment. However, the issue of support for the now-claimed subject matter is in question, as stated above, including the amount of antioxidant, if any, required by the claims. Note that this Office action properly places the application under Final Rejection, and thus a claim amendment after final rejection altering the amounts & percentages of the composition would require a new search of the prior art, and thus not be considered at such time.

Conclusion


Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith Hendricks whose telephone number is (571) 272-1401. The examiner can normally be reached on M-F (8:30am-6pm); First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


KEITH HENDRICKS
PRIMARY EXAMINER